



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

EX PARTE HICKMAN *et al.*

Application for Patent
FOR
AUTOMATIC ELECTRONIC DOCUMENT FILING SYSTEM, METHOD, AND
ARTICLE OF MANUFACTURE

Serial No. 09/625,300

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Examined by KYLE R. STORK Art Unit 2178

APPEAL BRIEF

CERTIFICATE OF MAILING

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I. REAL PARTY IN INTEREST

The real party in interest is G&H Nevada-Tek.

II. RELATED APPEALS AND INTERFERENCES

The following appeals may be related. Decisions are provided in Appendix XI.

Atty. Dock. No.	USSN	Patent No.	Remarks
HSC1P001.US01	09/648,715	7,082,439	BPAI decision 1/27/06
HSC1P003.US01	09/488,862	n/a	BPAI decision 3/9/05 BPAI decision 6/19/08
HSC1P004.US01	09/488,863	n/a	BPAI decision 3/19/08 CAFC decision 4/3/09
HSC1P005.US01	09/488,962	n/a	BPAI decision 5/4/2011

III. STATUS OF THE CLAIMS

Claims 1, 14-17, 21-32 and 36 are pending in this application.

Claims 21-30 are withdrawn from consideration.

Claims 1, 14-17, 31, 32 and 36 are rejected and are the subject of this appeal.

IV. STATUS OF THE AMENDMENTS

All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Certain embodiments, set forth by way of example and not limitation, have been claimed in the subject application. Support for the claim elements can be found generally throughout the specification and drawings with examples. However, such examples are not exhaustive and are merely provided to facilitate in the claim construction process.

In the embodiment of claim 1, set forth by way of example and not limitation, an automated electronic filing system includes: a web server coupled to the Internet [See, for example: Fig. 1; page 6, line 3 to page 8, line 23]; a receiving agency server separate from the web server and coupled to the Internet such that it is capable of communication with the web server [See, for example: Fig. 1; page 6, line 3 to page 8, line 23], wherein communication between the receiving agency server and the web server is subject to authentication and is at least partially encrypted [See, for example: Fig. 1; page 6, line 3 to page 8, line 23; Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19]; a client machine separate from the web server and the receiving agency server and coupled to the Internet for communication with the web server, wherein communication between the client machine and the web server is subject to authentication and is at least partially encrypted [See, for example: Fig. 1; page 6, line 3 to page 8, line 23; Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19], wherein the web server provides the client machine with a form which can be verified by the web server using heuristics [See, for example: Fig. 1; page 6, line 3 to page 8, line 23; Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19], the client machine providing information to the web server forming at least a part of an electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves as an interface to the receiving agency computer for the client machine [See, for example: Fig. 1; page 6, line 3 to page 8, line 23; Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19], the electronic document filed for further processing by a receiving agency associated with the receiving agency server in accordance with a procedure for which the receiving agency is in some manner responsible [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to

page 12, line 19]; and wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , wherein the form includes at least one of a blank form and a partially filled-in form based upon information stored on the web server [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , wherein the form can be at least partially automatically filled-in in response to the selection [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , wherein the web server automatically updates docketing information [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , and wherein the web server transacts a financial transaction with the receiving agency server on behalf of the client machine [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] .

In the embodiment of claim 31, set forth by way of example and not limitation, an automated electronic filing system for use in electronic prosecution of trademark applications includes: a web server coupled to a wide area network [See, for example: Fig. 1; page 6, line 3 to page 8, line 23]; a receiving agency server separate from the web server and coupled to the wide area network such that it is capable of communicating with the web server, the receiving agency server associated with a governmental agency responsible for the administration of trademark registration [See, for example: Fig. 1; page 6, line 3 to page 8, line 23]; a client machine separate from the web server and the receiving agency server and coupled to the wide area network for communication with the web server, such that the web server serves as an interface to the receiving agency server [See, for example: Fig. 1; page 6, line 3 to page 8, line 23], the client machine providing information to the web server forming at least a part of an electronic document related to prosecution of a trademark application or maintenance of a trademark registration [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , the electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves as an interface to the receiving agency computer [See, for example: Fig. 2, page 8, line 24 to

page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , the electronic document filed for further processing by the governmental agency in accordance with preestablished rules [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] ; wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine, wherein the web server provides the client machine with a form, wherein the form can be at least partially automatically filled-in in response to the selection [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] ; and wherein the web server serves as an interface between the client machine and the receiving agency server [See, for example: Fig. 1; page 6, line 3 to page 8, line 23; Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , and wherein the web server makes a payment to the government agency for the filing of the electronic document [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] .

In the embodiment of claim 32, set forth by way of example and not limitation, an automated electronic filing system includes: a web server capable of communicating over the Internet [See, for example: Fig. 1; page 6, line 3 to page 8, line 23]; a receiving agency server separate from the web server and capable of communicating over the Internet, the receiving agency server associated with a governmental agency [See, for example: Fig. 1; page 6, line 3 to page 8, line 23]; a client machine separate from the web server and the receiving agency server and capable of communicating over the Internet, such that the web server serves as an interface to the receiving agency server [See, for example: Fig. 1; page 6, line 3 to page 8, line 23], the client machine providing information to the web server forming at least a part of an electronic document [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , the electronic document to be filed with the receiving agency server by the web server for further processing by the governmental agency in accordance with pre-established rules [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , wherein the web server serves as an interface between the client machine and the receiving agency server [See, for example: Fig. 1; page 6, line 3 to page 8, line 23; Fig.

2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , whereby the receiving agency server communicates with the web server as if the receiving agency server were communicating directly with the client machine [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19]; and wherein the web server makes a payment to the governmental agency on behalf of a client for the filing of the electronic document [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] .

In the embodiment of claim 36, set forth by way of example and not limitation, a communications system includes: a client computer coupled to the Internet [See, for example: Fig. 1; page 6, line 3 to page 8, line 23]; an applicant computer coupled to the Internet and communicating with the client computer [See, for example: Fig. 1; page 6, line 3 to page 8, line 23]; an intermediary server coupled to the Internet communicating with the client computer [See, for example: Fig. 1; page 6, line 3 to page 8, line 23], the client computer serving as an intermediary between the applicant computer and the intermediary computer [See, for example: Fig. 1; page 4, lines 10-14 and page 6, line 3 to page 8, line 23]; and a recipient server coupled to the Internet and communicating with the intermediary server [See, for example: Fig. 1; page 6, line 3 to page 8, line 23], the intermediary server serving as an interface between the client computer and the recipient server [See, for example: Fig. 1; page 6, line 3 to page 8, line 23]; [See, for example: Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] , whereby the recipient server communicates with the intermediary server as if the recipient server were communicating directly with the applicant computer [See, for example: Fig. 1; page 6, line 3 to page 8, line 23; Fig. 2, page 8, line 24 to page 9, line 33; Figs. 3A & 3B, page 9, line 34 to page 11, line 4 and page 11, line 20 to page 12, line 19] .

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The rejection of claim 36 under 35 U.S.C. 102(e) as being anticipated by Takano et al., U.S. Patent No. 6,434,580 (“**Takano**”)
- B. The rejection of claims 1 and 14-17 under 35 U.S.C. 103(a) as being unpatentable over **Takano** and further in view of Brown et al., U.S. Patent No. 6,671,805 (“**Brown**”)
- C. The rejection of claims 31 and 32 under 35 U.S.C. 103(a) as being unpatentable over **Takano** and further in view of Daleen et al., U.S. Patent No. 6,493,722 (“**Daleen**”)

VII. ARGUMENTS

- A. The rejection of claim 36 under 35 U.S.C. 102(e) as being anticipated by Takano et al., U.S. Patent No. 6,434,580 (“**Takano**”) is in error and should be reversed

It is well established that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” This is often referred to as the “all elements rule” or “all limitations rule.” That is, in order to demonstrate anticipation, the proponent must show “that the four corners of a single, prior art document describe every element of the claimed invention.” *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). Moreover, the reference must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). As will be noted below, **Takano** does not describe every element of the claimed invention, nor does he arrange the elements as in claim 26.

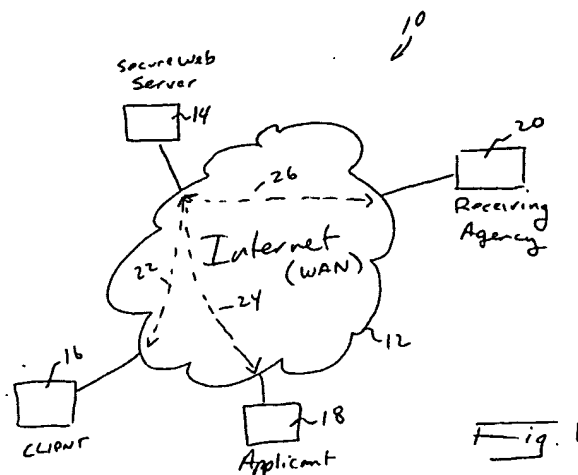
Claim 36 is reproduced below:

36. A communications system includes:
a *client computer* coupled to the *Internet*;
an *applicant computer* coupled to the Internet and communicating with the client computer;
an *intermediary server* coupled to the Internet communicating with the client computer, *the client computer serving as an intermediary between the applicant computer and the intermediary computer*; and
a *recipient server* coupled to the Internet and communicating with the intermediary server, *the intermediary server serving as an interface between the client computer and the recipient server*, whereby the *recipient server communicates with the intermediary server as if the recipient server were communicating directly with the applicant computer*.

Appellant’s Fig. 1 can be used to help illustrate this claim. In Fig. 1, a client computer 16 is coupled to the Internet 12. An applicant computer 18 is also coupled to the Internet 12 and communicates with the computer 16. An intermediary server 14 is coupled to the Internet 12 and communicates with the client computer 16 as indicated at 22. The client computer serves as an intermediary between the applicant computer 18 and the intermediary computer 14.¹ A recipient computer 20 is coupled to the Internet 12 and communicates with the intermediary computer 14 as indicated at 26.

¹ Fig. 1 is illustrating a slightly different embodiment than is claimed in claim 36. Support for this limitation can be found on page 4, lines 10-14.

The recipient computer 20 communicates with the intermediary server 14 as if the recipient server were communicating directly with the applicant computer 18.

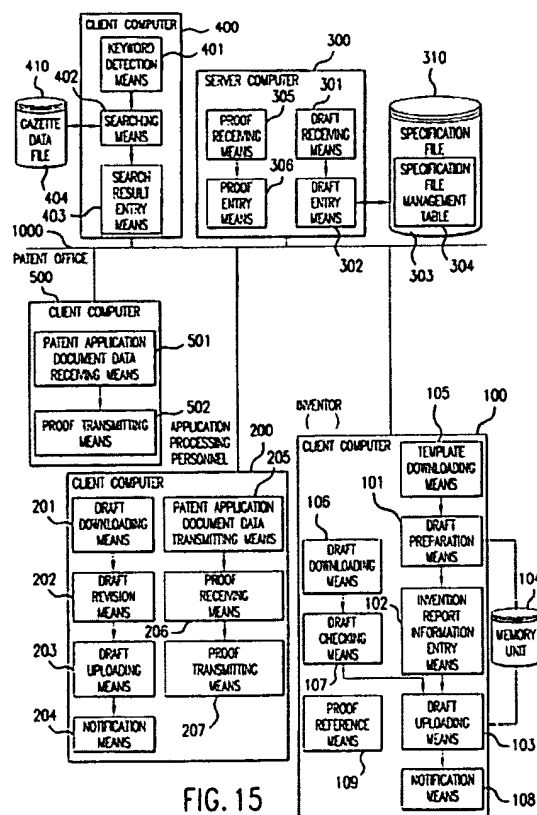


Claim 36 is therefore clearly describing a system of four computers (*e.g.* workstations, servers, personal computers, etc.), where each of the computers is coupled to and communicates through the Internet, and where the recipient computer 20 communicates with the Appellant computer 18 via the intermediary server 14 as if the recipient server were communicating directly with the applicant computer 18. The communication path through the Internet is therefore applicant computer to client computer to intermediary computer to recipient computer and vice versa, where the recipient computer 20 believes that it is communicating directly with the applicant computer 18.

Takano teaches a system whereby a patent application is prepared, on-line (*e.g.* over the Internet), for a client (*e.g.* patent applicant). After the application is prepared, it is downloaded to the client's computer. After verification by the client/applicant, it is transmitted to the USPTO. Therefore, **Takano** teaches a conventional network where one computer speaks directly to another, without the intermediaries of Appellant's claimed embodiment.

The Examiner primarily relies on Fig. 15 of **Takano** to support his rejection. As seen below, **Takano** does not make use of a system of four computers where the communication through the Internet is chained (applicant computer – client computer – intermediary computer –

recipient computer) through the Internet as set forth in the claim. Instead, with *Takano*, the client computer downloads a patent application from a first server and then transmits it to the USPTO. This is clearly does not meet the limitations of claim 36.



Therefore, *Takano* does not teach the elements of an applicant computer – client computer – intermediary computer – recipient computer arranged such they communicate through the Internet in a chained manner. Furthermore, *Takano* does not teach the limitation that the recipient computer communicates with the intermediary server as if it were communicating directly with the applicant computer. Therefore, *Takano* does not teach all of the elements of the claim and does not arrange the elements as recited in the claim. Appellants respectfully request that the rejection of claim 36 under 35 U.S.C. 102(e) be reversed.

- B. The rejection of claims 1 and 14-17 under 35 U.S.C. 103(a) as being unpatentable over *Takano* and further in view of Brown et al., U.S. Patent No. 6,671,805 (“*Brown*”) is in error and should be reversed

With respect to the Examiner’s rejections under 35 U.S.C. 103(a), when determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)). As will be shown, the combination of *Takano* and *Brown* also does not show all of the elements as recited in the rejected claims.

1. An automated electronic filing system includes:
 - a *web server* coupled to the *Internet*;
 - a *receiving agency server* separate from the web server and coupled to the Internet such that it is capable of communication with the web server, *wherein communication between the receiving agency server and the web server is subject to authentication and is at least partially encrypted*;
 - a *client machine* separate from the web server and the receiving agency server and coupled to the Internet for communication with the web server, *wherein communication between the client machine and the web server is subject to authentication and is at least partially encrypted*, wherein the *web server provides the client machine with a form* which can be *verified by the web server using heuristics*, the *client machine providing information to the web server forming at least a part of an electronic document* to be filed with the receiving agency server by the web server in a manner that the *web server serves as an interface to the receiving agency computer for the client machine*, the electronic document filed for further processing by a receiving agency associated with the receiving agency server in accordance with a procedure for which the receiving agency is in some manner responsible; and
 - wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine*, wherein the *form includes at least one of a blank form and a partially filled-in form based upon information stored on the web server*, wherein the form can be at least partially automatically filled-in in response to the selection, wherein the *web server automatically updates docketing information*, and wherein the *web server transacts a financial transaction* with the receiving agency server on behalf of the client machine.

Takano is relied upon by the Examiner for the limitations of a web server, a receiving agency server and a client machine communicating through Internet. However, as noted above, **Takano** does not provide web server forming a “middle-man” between the receiving agency computer and the client machine. That is, the communication path through the Internet is client machine – web server – receiving agency computer and vice versa.

Furthermore, in claim 1 the intermediary web server does much more. The web server provides authentication and encryption in its communications with both the client machine and the receiving agency computer. The web server also provides a form to the client machine and can fill in that form based upon information stored on the web server. The web server has a docketing function in that it automatically updates docketing information. Furthermore, the web server also transacts a financial transaction with the receiving agency server on behalf of the client.

Brown discloses a peer-to-peer document transmission system. Fig. 5 is an example.

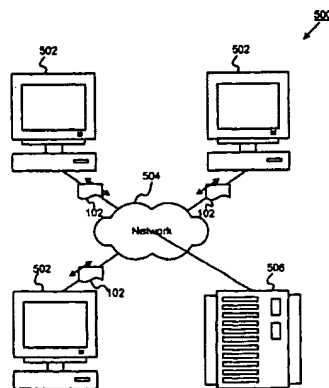


Fig. 5

Here, processing stations 502 can pass documents 102 and a name server 506 can be used so that the name servers can find each other. This is clearly a peer-to-peer system in that there is no intermediary provided.

The processing stations 502 can also communicate with a court system. See, for example, column 21, lines 19-28 of **Brown**:

The ability to transfer data between a document 102 and a DBMS is advantageous in many respects. For example, in the context of an electronic court filing system, the database interaction service 708 may be used to automatically update a court docketing system whenever a document 102 is received, signed, or otherwise processed by a processing station 502. As a result, the database interaction service 708 eliminates the need for a filing clerk to manually enter such data, saving time and effort and increasing accuracy.

This is clearly not through the intermediary of a web server. That is, the processing station (“client”) is directly communicating with the court document system and the “automatic updating” of the court docketing system is performed by the client, not a web server.

As seen in Fig. 7 of *Brown*, the cited functionalities of verification, encryption, docketing and financial transaction take place on the processing station 502 (as is traditional). *Brown*, like *Takano*, does not teach a web server in the middle between a client machine and a receiving agency computer performing the recited functions. Furthermore, with respect to financial transactions, *Brown* only teaches that the document being sent might include information about payment, which is decidedly different than a web server which transacts a financial transaction with a receiving agency computer on behalf of a client machine.

For at least the foregoing reasons, the rejection of claim 1 as being unpatentable over *Takano* in view of *Brown* was in error and should be reversed. The rejection of dependent claims 14-17 was in error for at least the same reasons and should also be reversed.

- C. The rejection of claims 31 and 32 under 35 U.S.C. 103(a) as being unpatentable over *Takano* and further in view of Daleen et al., U.S. Patent No. 6,493,722 (“*Daleen*”) is in error and should be reversed

Claims 31 and 32 are reproduced below:

31. An automated electronic filing system for use in electronic prosecution of trademark applications includes:
a *web server* coupled to a *wide area network*;
a *receiving agency server* separate from the web server and coupled to the wide area network such that it is capable of *communicating with the web server*, the receiving agency server associated with a governmental agency responsible for the administration of trademark registration;
a *client machine* separate from the web server and the receiving agency server and coupled to the wide area network for communication with the web server, such that the *web server serves as an interface to the receiving agency server*, the client machine providing information to the web server forming at least a part of an *electronic document* related to

prosecution of a trademark application or maintenance of a trademark registration, the electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves as an interface to the receiving agency computer, the electronic document filed for further processing by the governmental agency in accordance with preestablished rules;

wherein the *web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine*, wherein the web server provides the client machine with a form, wherein the form can be at least partially *automatically filled-in in response to the selection*; and

wherein the web server serves as an interface between the client machine and the receiving agency server, and wherein the *web server makes a payment to the government agency for the filing of the electronic document*.

32. An automated electronic filing system includes:

a *web server* capable of communicating over the *Internet*;

a *receiving agency server* separate from the web server and capable of communicating over the Internet, the receiving agency server associated with a governmental agency;

a *client machine* separate from the web server and the receiving agency server and capable of communicating over the Internet, such that the *web server serves as an interface to the receiving agency server*, the client machine providing information to the web server forming at least a part of an electronic document, the *electronic document* to be filed with the receiving agency server by the web server for further processing by the governmental agency in accordance with pre-established rules, wherein the *web server serves as an interface between the client machine and the receiving agency server, whereby the receiving agency server communicates with the web server as if the receiving agency server were communicating directly with the client machine*; and

wherein the *web server makes a payment to the governmental agency on behalf of a client for the filing of the electronic document*.

Appellants incorporate by reference their arguments with respect to *Takano* as set forth above. *Takano* does not teach a web server that serves as an interface between a client machine and a receiving agency computer as recited in the claim. *Takano* also does not describe a web server interface which makes a payment on behalf of a client machine, nor a system where a receiving agency computer is communicating with a web server as if it were communicating directly with the client machine.

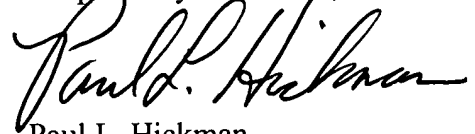
Daleen does not cure the deficiencies of *Takano* with respect to the missing elements. *Daleen* does not show a receiving agency server as asserted by the Examiner let alone an intermediary web server that serves as an interface to a receiving agency server. Furthermore, there is no description or suggestion in *Daleen* of an intermediate web server conducting a financial transaction with a receiving agency server on behalf of a client machine. *Daleen* also does not teach the automatic filling of electronic documents.

For at least the foregoing reasons, the rejections of claims 31 and 32 as being unpatentable over *Takano* in view of *Daleen* is also in error and should be reversed. The Examiner has failed to show all of the elements as recited in the claims in the cited art.

VIII. CONCLUSION

The rejections of claims 1, 14-17, 31, 32 and 36 were clearly in error for at least the reasons set forth above. Appellants respectfully request that the rejection of the claims be reversed.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Paul L. Hickman", written in a cursive style.

Paul L. Hickman
Reg. No. 28,516

IX. CLAIMS APPENDIX

1. An automated electronic filing system includes:

a web server coupled to the Internet;

a receiving agency server separate from the web server and coupled to the Internet such that it is capable of communication with the web server, wherein communication between the receiving agency server and the web server is subject to authentication and is at least partially encrypted;

a client machine separate from the web server and the receiving agency server and coupled to the Internet for communication with the web server, wherein communication between the client machine and the web server is subject to authentication and is at least partially encrypted, wherein the web server provides the client machine with a form which can be verified by the web server using heuristics, the client machine providing information to the web server forming at least a part of an electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves as an interface to the receiving agency computer for the client machine, the electronic document filed for further processing by a receiving agency associated with the receiving agency server in accordance with a procedure for which the receiving agency is in some manner responsible; and

wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine, wherein the form includes at least one of a blank form and a partially filled-in form based upon information stored on the web server, wherein the form can be at least partially automatically filled-in in response to the selection, wherein the web server automatically updates docketing information, and wherein the web server transacts a financial transaction with the receiving agency server on behalf of the client machine.

14. An automated electronic filing system as recited in claim 1 further includes an applicant machine coupled to the Internet.

15. An automated electronic filing system as recited in claim 14 wherein the applicant machine communicates with the web server the Internet.

16. An automated electronic filing system as recited in claim 15 wherein communications between the applicant machine and the web server are at least partially encrypted.

17. An automated electronic filing system as recited in claim 16 wherein communications between the applicant machine and the web server are subject to authentication.

31. An automated electronic filing system for use in electronic prosecution of trademark applications includes:

- a web server coupled to a wide area network;

- a receiving agency server separate from the web server and coupled to the wide area network such that it is capable of communicating with the web server, the receiving agency server associated with a governmental agency responsible for the administration of trademark registration;

- a client machine separate from the web server and the receiving agency server and coupled to the wide area network for communication with the web server, such that the web server serves as an interface to the receiving agency server, the client machine providing information to the web server forming at least a part of an electronic document related to prosecution of a trademark application or maintenance of a trademark registration, the electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves as an interface to the receiving agency computer, the electronic document filed for further processing by the governmental agency in accordance with preestablished rules;

- wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine, wherein the web server provides the client machine with a form, wherein the form can be at least partially automatically filled-in in response to the selection; and

- wherein the web server serves as an interface between the client machine and the receiving agency server, and wherein the web server makes a payment to the government agency for the filing of the electronic document.

32. An automated electronic filing system includes:

a web server capable of communicating over the Internet;

a receiving agency server separate from the web server and capable of communicating over the Internet, the receiving agency server associated with a governmental agency;

a client machine separate from the web server and the receiving agency server and capable of communicating over the Internet, such that the web server serves as an interface to the receiving agency server, the client machine providing information to the web server forming at least a part of an electronic document, the electronic document to be filed with the receiving agency server by the web server for further processing by the governmental agency in accordance with pre-established rules, wherein the web server serves as an interface between the client machine and the receiving agency server, whereby the receiving agency server communicates with the web server as if the receiving agency server were communicating directly with the client machine; and

wherein the web server makes a payment to the governmental agency on behalf of a client for the filing of the electronic document.

36. A communications system includes:

a client computer coupled to the Internet;

an applicant computer coupled to the Internet and communicating with the client computer;

an intermediary server coupled to the Internet communicating with the client computer, the client computer serving as an intermediary between the applicant computer and the intermediary computer; and

a recipient server coupled to the Internet and communicating with the intermediary server, the intermediary server serving as an interface between the client computer and the recipient server, whereby the recipient server communicates with the intermediary server as if the recipient server were communicating directly with the applicant computer.

X. EVIDENCE APPENDIX

None.

XI. RELATED PROCEEDINGS APPENDIX

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

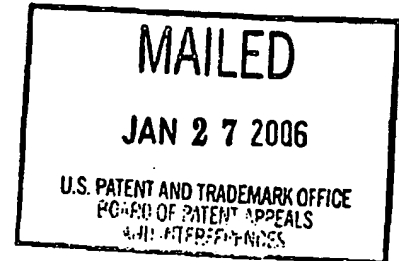
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN AND JAMES J. GOUGH

Appeal No. 2005-2460
Application No. 09/648,715

ON BRIEF



Before RUGGIERO, BARRY, and NAPPI, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 3-5, 7, 9, 11-14, and 16-18, which are all of the claims pending in the present application.

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Application No. 09/648,715

The claimed invention relates to a system and method for electronic mail notification in which a determination is made that it is time for at least one of a reminder notification action and a report notification action. For a reminder notification action, all action items which fall within a given range are obtained and processed into a reminder action item report and e-mailed to at least one designated recipient. For a report notification action, a list of completed action items in a given range is obtained and processed into a completed action report and e-mailed to at least one designated recipient.

Claim 1 is illustrative of the invention and reads as follows:

A method for electronic mail notification comprising:
determining that it is a time for at least one of a reminder notification action and a report notification action;
opening a docketing program;
running a report;
saving the report for further processing;
for a reminder notification action, obtaining all action items within a given range from said report and processing the action items into at least one action item report and e-mailing the at least one action item report to at least one designated recipient; and

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Application No. 09/648,715

for a report notification action, obtaining a list of completed action items in a given range from said report and processing the list of completed action items into at least one completed action report and e-mailing the at least one completed action report to at least one designated recipient.

The Examiner relies on the following prior art:

Milewski et al. (Milewski)	5,930,471	Jul. 27, 1999 (filed Dec. 26, 1996)
Ariyama et al. (Ariyama) (Published Japanese Patent Application)	11-143936	May 28, 1999

Claims 1, 3-5, 7, 9, 11-14, and 16-18, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Milewski in view of Ariyama.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

Initially, we note that Appellants have provided arguments as to the sufficiency of the drawings. However, the issue of the sufficiency of the drawings relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining

¹ The Appeal Brief (revised) was filed August 10, 2004. In response to the Examiner's Answer mailed October 19, 2004, a Reply Brief was filed December 23, 2004, which was acknowledged and entered by the Examiner as indicated in the communication mailed March 16, 2005.

Appeal No. 2005-2460
Application No. 09/648,715

Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by Appellants on pages 5 and 6 of the Brief and pages 1-3 of the Reply Brief.

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 1, 3-5, 7, 9, 11-14, and 16-18. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one

Appeal No. 2005-2460

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having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 5, 7, 9, 12-14, 17, and 18 based on the combination of Milewski and Ariyama, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since proper motivation for the Examiner's proposed combination has not been set forth. In addition, Appellants assert that, even if combined, all of the claimed limitations would not be taught or suggested by the applied

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Milewski and Ariyama references. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

In our view, to whatever extent the missing reminder time determination feature of Milewski may be present in Ariyama, we find no indication from the Examiner as to how and in what manner the Milewski reference would be combined with Ariyama to arrive at the claimed invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

We are further of the view that, even assuming arguendo that proper motivation were established for the combination of Milewski and Ariyama, the resultant combination would not satisfy the particular limitations of the appealed claims. As asserted by Appellants (Brief, page 7; Reply Brief, page 3), we find no disclosure in Milewski, or in Ariyama, which would satisfy the

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Application No. 09/648,715

"opening a docketing program" feature which appears in each of the appealed independent claims. We agree with Appellants that the portion of Milewski relied upon by the Examiner, i.e., column 8, lines 30-37 which is directed to the accessing of a structured response template by a sender, has no relationship to a "docketing program" as claimed.

We recognize that the Examiner, at page 8 of the Answer, has expanded the line of reasoning which asserts that Milewski provides a disclosure of the claimed "docketing program." According to the Examiner, the accessing of controller 12 by sender station 14 in Milewski using conventional stored program instructions would satisfy the claimed "opening a docketing program" limitation. We can find no basis on the record before us for the Examiner interpreting the claim language in this manner. In our view, the Examiner's interpretation could only be reached by pointedly ignoring the precise language of the claims on appeal, i.e., effectively and improperly reading out the language "docketing program" from the claims. Our reviewing courts have held that, in assessing patentability of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the

patentability of that claim against the prior art. In re Wilson,
424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

REVERSED

BOARD OF PATENT
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8

Appeal No. 2005-2460
Application No. 09/648,715

PERKINS COIE LLP
101 JEFFERSON DRIVE
MENLO PARK, CA 94025-1114

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

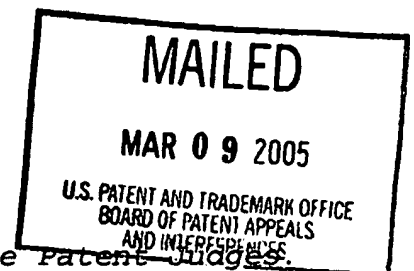
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN and JAMES J. GOUGH

Appeal No. 2004-1838
Application No. 09/488,862

ON BRIEF



Before HAIRSTON, KRASS, and OWENS, Administrative Patent Judges.
OWENS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-15 and 17-21, which are all of the pending claims.

THE INVENTION

The appellants claim a computer implemented method, an electronic document filing system and a computer program for electronically filing documents with a receiving agency. Claim 1, which claims the computer implemented method, is illustrative:

Appeal No. 2004-1838
Application No. 09/488,862

1. A computer implemented method for electronically filing documents with a receiving agency:
receiving unencrypted electronic document data comprising an HTML form at a client computer via a computer network, wherein the electronic document data is related to an electronic document to be securely filed with a receiving agency computer also connected to said computer network;
adding information to the electronic document data using a browser running on the client computer to develop processed electronic document data;
encrypting the processed electronic document data before providing it to the receiving agency computer over the network, whereby the receiving agency computer decrypts the processed electronic document data and eventually processes the electronic document data and files the electronic document corresponding to the processed electronic document data at the receiving agency;
and
providing a response to the client computer, wherein the response includes information related to the electronic document as filed with the receiving agency computer.

THE REFERENCES

Hitchcock et al. (Hitchcock) 6,345,278 Feb. 5, 2002
(filed Jun. 3, 1999)

M. Muramatsu et al. (Muramatsu), "The Construction of the Paperless System in Japan Patent Office" 278-87, IEEE 0-8186-2697 (June, 1992).

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-12, 14, 15 and 17-21 over Hitchcock, and claim 13 over Hitchcock in view of Muramatsu.

OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1, 8 and 15.¹

Claim 1 requires encrypting processed electronic document data before providing it from a client computer to a receiving agency computer over a network, whereby the receiving agency computer decrypts the processed electronic document data. Claim 8 requires encrypting processed electronic data before it is transmitted from a client computer, receiving the encrypted, processed electronic document data at a receiving agency computer via a computer network, and decrypting the processed electronic document data. Claim 15 requires a code segment on a client computer that encrypts processed electronic document data, and a code segment on the client computer that provides the encrypted, processed electronic document data to a receiving agency computer.

Hitchcock discloses (col. 2, lines 1-12):

The present invention comprises a universal forms engine that permits the creation and processing of customizable electronic forms and selective sharing of information between the customized forms. A user thus enters data only once, and the data is shared through

¹ The examiner does not rely upon Muramatsu for any disclosure that remedies the deficiency in Hitchcock as to the independent claims.

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Application No. 09/488,862

an extensible database between disparate forms. The forms are completed by a user over a computer network and information from each completed form is forwarded to the appropriate entity over a computer network. The ability of the forms engine to present a form for user input, to receive data from the user, and to provide the data to the appropriate entity is independent of the computing platform of the user and the entity.

The examiner incorrectly states that Hitchcock discloses encrypting and decrypting processed electronic document data (answer, page 3). The examiner then acknowledges that Hitch does not disclose encrypting and decrypting processed electronic document data, and argues that "transferring data between two computers connected by an open communication channel in a secure and encrypted manner is a well-established practice" (answer, pages 3-4). In support of that argument the examiner relies upon two references other than Hitchcock and Muramatsu (answer, page 6). Because the additional references are not included in the statement of the rejection, they are not properly before us. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Accordingly, we have not considered those references in reaching our decision.

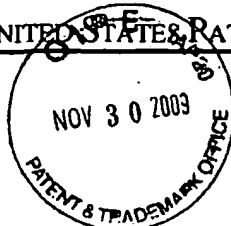
The examiner's argument is not well taken even if encryption and decryption were well known in the art at the time of the appellants' invention. To establish a *prima facie* case of obviousness of the claimed invention the examiner must provide

Appeal No. 2004-1838
Application No. 09/488,862

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,862	01/21/2000	Paul L. Hickman	HSC1P003.US01	5033

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EXAMINER

FISCHER, ANDREW J

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3621

MAIL DATE	DELIVERY MODE
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06/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN and JAMES J. GOUCH

Appeal No. 2008-0830
Application No. 09/488,862
Technology Center 3600

Decided: June 19, 2008

Before WILLIAM F. PATE, III, TERRY J. OWENS and ANTON W. FETTING,
Administrative Patent Judges.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

The Appellants appeal from a rejection of claims 1-15 and 17-21, which are all of the pending claims.

THE INVENTION

The Appellants claim a method, electronic document filing system and computer program for filing documents with a receiving agency. Claim 1 is illustrative:

1. A computer implemented method for electronically filing documents with a receiving agency:

receiving unencrypted electronic document data comprising an HTML form at a client computer via a computer network, wherein the electronic document data is related to an electronic document to be securely filed with a receiving agency computer also connected to said computer network;

adding information to the electronic document data using a browser running on the client computer to develop processed electronic document data;

encrypting the processed electronic document data before providing it to the receiving agency computer over the network, whereby the receiving agency computer decrypts the processed electronic document data and eventually processes the electronic document data and files the electronic document corresponding to the processed electronic document data at the receiving agency; and

providing a response to the client computer, wherein the response includes information related to the electronic document as filed with the receiving agency computer.

THE REFERENCES

Hitchcock US 6,345,278 B1 Feb. 5, 2002

Muramatsu et al., "The Construction of the Paperless System in Japan Patent Office" 278-87, IEEE 0-8186-2697 (June 1992).

Purcell et al., "Electronic Patent Application Filing System (EPAFS): A Demonstration Project of the U.S. Patent and Trademark Office", 38 *Jurimetrics J.* 407 (1998).

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-12, 14, 15 and 17-21 over Hitchcock in view of Purcell, and claim 13 over Hitchcock in view of Purcell and Muramatsu.

OPINION

We reverse the Examiner's rejections. We need to address only the independent claims, i.e., claims 1, 8 and 15.¹ Each of those claims requires receiving unencrypted electronic document data comprising an HTML form at a client computer via a computer network, adding information to the electronic document data using a browser running on the client computer to produce processed electronic document data, and encrypting the processed electronic document data before providing it to a receiving agency computer over the network.

Hitchcock discloses (col. 2, ll. 1-12):

The present invention comprises a universal forms engine that permits the creation and processing of customizable electronic forms and selective sharing of information between the customized forms. A user thus enters data only once, and the data is shared through an extensible database between disparate forms. The forms are completed by a user over a computer network and information from each completed form is forwarded to the appropriate entity over a computer network. The ability of the forms engine to present a form for user input, to receive data from the user, and to provide the data to the appropriate entity is independent of the computing platform of the user and the entity.

Purcell discloses a proposed U.S. Patent and Trademark Office electronic patent application filing system wherein:

Transmission level security will be provided by strong encryption systems integrated in domestic WWW browsers providing 128-bit SSL. The stored patent application information and the composite PDF file are strongly encrypted using triple-DES [p. 8, ¶ 2].

¹ The Examiner does not rely upon Muramatsu for any disclosure that remedies the deficiency in Hitchcock and Purcell as to the independent claims (Ans. 5).

The Examiner argues that “it would have been obvious to one having ordinary skill in the art at the time of the invention to have included the steps of using SSL protocol or any other secure and encrypted methods to communicate in a secure manner data between a client computer and a server for the motivation of privacy, confidentiality and prevention of unauthorized parties from eavesdropping” (Ans. 3-4).

The Examiner does not address, in either the explanation of the rejection (Ans. 3-4) or the response to arguments (Ans. 5-10), the Appellants’ independent claim requirements set forth above of receiving unencrypted electronic data at a client computer over a computer network, adding information to the electronic data at the client computer to produce processed electronic document data, and encrypting the processed electronic document data before sending it to another computer over the network. The Examiner refers us to Purcell to provide the encryption limitations. This alone is insufficient to complete a prima facie case because the Examiner does not make any findings as to the serial set of unencrypted followed by encrypted transactions as claimed, nor does the Examiner even provide a rationale for such a combination.

The Examiner, therefore, has not established a prima facie case of obviousness of the Appellants’ claimed invention.

DECISION

The rejections under 35 U.S.C. § 103 of claims 1-12, 14, 15 and 17-21 over Hitchcock in view of Purcell, and claim 13 over Hitchcock in view of Purcell and Muramatsu are reversed.

REVERSED

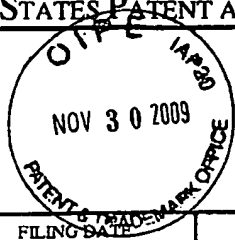
Appeal 2008-0830
Application 09/488,862

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,863	01/21/2000	Paul L. Hickman	59628-8004.US01	5034

45965 7590 03/19/2008
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LOS ALTOS, CA 94023-1639

EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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MAIL DATE	DELIVERY MODE
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03/19/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN and JAMES J. GOUGH

Appeal 2007-3206
Application 09/488,863
Technology Center 2100

Decided: March 19, 2008

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and JEAN R.
HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-21. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

Many governmental agencies allow the electronic filing of legal documents. For example, some courts allow complaints and briefs to be filed electronically. For another example, the United States Patent and Trademark Office allows trademark applications to be filed electronically. (Spec. 1.)

According to the invention at issue on appeal, a client computer sends data to an electronic document filing server via a computer network. Generally, the data concern an electronic document to be filed with an agency's computer, which is separate from the client computer and the server. The electronic document filing server processes the data and provides the processed data to the agency's computer. When the latter computer files the data, the server provides a response, including information related to the filed data, to the client computer. (*Id.* 35.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A computer implemented method for electronically filing documents with a receiving agency utilizing a remote server, the computer implemented method comprising the operations of:

receiving electronic document data at an electronic document filing server from a remote client computer via a

computer network, wherein the electronic document data is related to an electronic document to be filed with a receiving agency computer separate from both the client computer and the electronic document filing server, said electronic document data being entered via a web browser application being executed on said client computer;

processing the electronic document data utilizing the electronic document filing server;

providing the processed electronic document data to the receiving agency computer via the electronic document filing server, wherein the receiving agency computer eventually files the processed electronic document data; and

providing a response to the client computer via the electronic document filing server, wherein the response includes information related to electronic document data as filed with the receiving agency computer.

C. REJECTION

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,185,683 ("Ginter") and U.S. Patent Application Pub. No. 2002/0059235 ("Jecha").

II. CLAIMS 1-4, 8-11, AND 15-18

1 "When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue

claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(vii) (2006).¹ Here, the Appellants argue claims 1-4, 8-11, and 15-18, which are subject to the same ground of rejection, as a group. (Sub. App. Br.² 5-12.) We select claim 1 as the sole claim on which to decide the appeal of the group. "With this representation in mind, rather than reiterate the positions of the parties *in toto*, we focus on the issues therebetween." *Ex Parte Zettel*, No. 2007-1361, 2007 WL 3114962, at *2 (BPAI 2007).

A. CLIENT COMPUTER

The Examiner finds, "Ginter teaches an inventor/applicant 5060 could use electronic appliance 600[A] (*i.e., the client computer*)" (Rev. Ans.³ 9.) The Appellants argue, "The appliance 600 is clearly requires [sic] specialized software to communicate with the trusted electronic go-between 4700" (Reply Br. 2) and "The point that the Examiner repeatedly

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Substitute Appeal Brief. The current version includes the same rules.

² We rely on and refer to the Substitute Appeal Brief, in lieu of the original Appeal Brief, because the latter was defective. We will not consider the original in deciding this appeal.

³ We rely on and refer to the Revised Examiner's Answer, in lieu of the original Examiner's Answer, because the latter was defective. We will not consider the original in deciding this appeal.

misses is that Appellant's claimed embodiments allow a standard computer (without special purpose software) to communicate" (*Id.* 3.)

Therefore, the issue is whether the Appellants have shown error in the Examiner's finding that the claimed client computer reads on the electronic appliance 600A shown in Fig. 132.

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Here, the features on which the Appellants rely for patentability, viz., allowing a standard computer to communicate without special purpose software, are absent from the representative claim. Therefore, the arguments based on these features cannot show error in the Examiner's finding that the claimed client computer reads on the electronic appliance 600A shown in Fig. 132.

B. AGENCY COMPUTER

The Examiner finds, "Ginter teaches the trusted electronic go-between 4700 which is a computer that performs its functions electronically in a highly automatic and efficient way . . . and the secure electronic

archive 4702 are separate computers/servers" (Rev. Ans. 9.) The Appellants "submit[] that the trusted electronic go-between 4700 and the secure electronic archive 4702 collectively comprise the agency computer." (Reply Br. 2.) Therefore, the issue is whether Ginter teaches an agency computer separate from a client computer and an electronic document filing server.

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently" *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)). Furthermore, "[a]ll of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art." *In re Boe*, 355 F.2d 961, 965 (CCPA 1966)). "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968)).

Here, Ginter's "FIG. 132 shows how system 4050 might be used by Patent Office automation." (Col. 57, ll. 54-55). The system includes "a

trusted go-between 4700" (*id.* ll. 63-64) and "a secure electronic archive 4702" (col. 58, ll. 7-8). For its part, the reference's "FIG. 119 shows an example architecture for a trusted go-between 4700" (Col. 44, ll. 43-44.) More specifically, the latter Figure depicts the trusted go-between 4700 as "an electronic appliance 600" (*id.* ll. 45-46) that includes "a secure electronic archive 4072." (*Id.* ll. 47-48.) Based on these teaching, we agree with the Appellants that the trusted electronic go-between 4700 and the secure electronic archive 4702 collectively constitute the same computer. (Reply Br. 2.)

Ginter's system 4050, however, also includes an electronic appliance 600B, "such as [a] personal computer[] or computer workstation[]" (Col. 16, ll. 26-27.) Figure 132 shows that the electronic appliance 600B is separate from the system's trusted go-between 4700 and its client computer 600A. The reference's teaching that "[a] patent examiner 5064 could examine the patent application 5062 by requesting a copy of it from electronic archive 4702" (col. 58, ll. 13-15) also evidences that the patent examiner's appliance 600B is separate from the system's electronic archive 4702.

Because the appliance 600B receives and stores the requested copy for "review" (*id.* l. 20), we find that it "eventually files the processed electronic document data" as claimed. Ginter adds that "[t]he patent examiner 5064 could also use electronic appliance 600[B] to draft office actions and

notices." (*Id.* ll. 23-24.) Because "[t]he examiner 5064 could communicate these notices and actions via trusted go-between 4700 to the inventor 5060" (*id.* ll. 24-26) we further find that the appliance 600B "provid[es] a response to the client computer via the electronic document filing server, wherein the response includes information related to electronic document data as filed with the receiving agency computer" as claimed. Therefore, we also find that Ginter teaches an agency computer separate from a client computer and an electronic document filing server.

C. TEACHING TOWARD OR AWAY

The Examiner finds, "[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of **Ginter** and **Jecha** to have said electronic document data being entered via a web browser application being executed on said client computer" (Rev. Ans. 5.) He makes the following finding to support his conclusion.

One would have been motivated to do so to allow the system (or administrative user) to define the overall characteristics of a given design of a document via a document template such as HTML [i.e., HyperText Markup Language], such that other users can input information to be formatted in accordance with and/or as allowed by the document template in order to provide a consistent "look" over all the documents

created from a given template, even though all those documents may vary in some ways from one another (**Jecha, paragraph [0044]**).

(Rev. Ans. 5-6.) The Appellants argue that column 20, lines 44-46 of "Ginter teaches that additional software applications must be provided on the sending and receiving computers to accomplish the delivery functions. This teaches away from the concept of using an already installed web browser for communication between a client computer and an electronic document filing server." (Sub. App. Br. 11.) Therefore, the issue is whether the Appellants have shown that Ginter teaches away from using a web browser application to enter data.

"What the prior art teaches and whether it teaches toward or away from the claimed invention . . . is a determination of fact." *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir.1995). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Here, the part of Ginter relied on by the Appellants explains that the reference's "electronic delivery functions can be provided by software integrated with other software applications . . . executing on personal

computer 4116." (Col. 20, ll. 44-46.) We find that such an explanation teaches toward rather than away from integrating the electronic delivery function with other software applications. The reference further explains that "[s]uch delivery . . . may be performed by any convenient electronic means such as, for example, Internet, Electronic Mail or Electronic Mail Attachment, **WEB Page Direct**, . . . or any other electronic means to provide contact with the intended recipient(s)." (Col. 40, ll. 15-22 (emphasis added).) The Examiner's finding that "the Ginter system does implicitly teach about Web browser protocol in order to access WEB page Direct software application" (Rev. Ans. 11) is also uncontested.

Because Ginter teaches integrating its electronic delivery with other software applications and implicitly teaches using a Web browser protocol for delivery, the Appellants have not shown that Ginter teaches away from the use of a web browser application to enter data. Therefore, we affirm the rejection of claim 1 and of claims 2-4, 8-11, and 15-18, which fall therewith.

III. CLAIMS 5-7, 12-14, AND 19-21

Here, the Appellants argue claims 5, 6, 12, 13, 19, and 20, which are subject to the same ground of rejection, as a group. (Sub. App. Br. 12-13). We select claim 5 as the sole claim on which to decide the appeal of the group.

The Examiner finds, "[T]he trusted electronic go-between 4700 of **Ginter** is capable of providing a client computer and/or an applicant computer (*and/or any other authorized party processing the patent application*) with a response related to the electronic document data" (Rev. Ans. 12.) The "Appellants also fail to see the combination of a client computer and an applicant computer." (Reply Br. 6.) Therefore, the issue is whether the combined teachings of Ginter and Jecha would have suggested the combination of a client computer and an applicant computer.

"A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Here, Ginter's system 4050 also includes an electronic appliance 600A, "such as [a] personal computer[] or computer workstation[]" (Col. 16, ll. 26-27.) Using the electronic appliance 600A "an inventor 5060 might file her patent application 5062 by sending it to the Patent Office 5064" (Col. 57, ll. 55-57.) Claim 1 required "a receiving agency computer **separate** from both the client computer and the electronic document filing server" (Emphasis added.) Claim 5, in contrast, does not require the applicant computer to be "separate"

Appeal 2007-3206
Application 09/488,863

from the client computer. We find that the electronic appliance 600A would have suggested the combination of a client computer and an applicant computer. Therefore, we affirm the rejection of claim 5 and of claims 6, 12, 13, 19, and 20, which fall therewith.

Although they purport to argue claims 7, 14, and 21 as a separate group (Sub. App. Br. 13-14) the Appellants' argument for the latter claims is tantamount to that for claims 5, 6, 12, 13, 19, and 20, viz., that "the applicant computer, as defined in the claims and specification, is not taught or suggested by the cited art" (*Id.* 14.) Unpersuaded by this argument, we also affirm the rejection of claims 7, 14, and 21.

IV. ORDER

For the aforementioned reasons, we affirm the rejection of claims 1-21 under § 103(a).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2007-3206
Application 09/488,863

AFFIRMED

rwk

TECHNOLOGY & INTELLECTUAL PROPERTY
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NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

2008-1437
(Serial No. 09/488,863)

IN RE PAUL L. HICKMAN and JAMES J. GOUGH

Glenn E. Von Tersch, Technology & Intellectual Property Strategies Group PC, of Palo Alto, California, argued for appellants.

Nathan K. Kelley, Associate Solicitor, Office of the Solicitor, United States Patent and Trademark Office, of Alexandria, Virginia, argued for the Director of the United States Patent and Trademark Office. With him on the brief were Raymond T. Chen, Solicitor, and Shannon M. Hansen, Associate Solicitor.

Appealed from: United States Patent and Trademark Office
 Board of Patent Appeals and Interferences

NO. 2: This disposition is nonprecedent.

United States Court of Appeals for the Federal Circuit

2008-1437
(Serial No. 09/488,863)

IN RE PAUL L. HICKMAN and JAMES J. GOUGH

Judgment

ON APPEAL from the United States Patent and Trademark Office
Board of Patent Appeals and Interferences

in CASE NO(S). 09/488,863

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam (MAYER, PLAGER, and BRYSON, Circuit Judges).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

DATED APR - 3 2009

Jan Horbaly
Jan Horbaly, Clerk

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

APR - 3 2009

JAN HORBALY
CLERK

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ISSUED AS A MANDATE: MAY 26 2009

By: S. 16/11 Date: 5/26/09



1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6
7
8 *Ex parte* PAUL L. HICKMAN and JAMES J. GOUGH

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11 Appeal 2010-001275
12 Application 09/488,962
13 Technology Center 3600

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16
17 Before ANTON W. FETTING, BIBHU R. MOHANTY, and
18 KALYAN K. DESHPANDE, *Administrative Patent Judges*.

19
20 DESHPANDE, *Administrative Patent Judge*.

21
22
23 DECISION ON APPEAL

STATEMENT OF THE CASE¹

Paul L. Hickman et al. (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-21, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a system and method for the filing of legal documents over an unsecured network such as the Internet. Spec. 1:33-35.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A computer implemented method for electronically filing a document requiring an electronic signature utilizing a remote computer, the computer implemented method comprising the operations of:

[1] storing an electronic document on a first computer coupled to a computer network;

[2] providing a second computer with an electronic notification via the computer network, the electronic notification including a link to the electronic document stored on the first computer, the electronic notification further including a field for an electronic signature;

[3] receiving at the first computer the electronic notification from the second computer, the electronic notification including an electronic signature related to the electronic document stored on the first computer; and

[4] providing a receiving agency computer with the electronic signature, whereby a user of the second computer is able to electronically sign a document remotely.

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed April 13, 2009) and Reply Brief ("Reply Br.," filed September 29, 2009), and the Examiner's Answer ("Ans.," mailed July 23, 2009).

1 The Examiner relies upon the following prior art:

Ginter US 6,185,683 B1 Feb. 6, 2001

Takano US 6,434,580 B1 Aug. 13, 2002

American Bar Association, Annual Report of Committee
754, Section of Intellectual Property Law 1997-1998
Annual Report, Final Report Committee 754 (Mark K.
Dickson, ed., 1998)
(<http://www.abanet.org/intelprop/97-98rep/754.HTML>)
(last visited May 20, 2004) (hereinafter "ABA").

2 Claims 1, 8, and 15 stand rejected under 35 U.S.C. § 112, second
3 paragraph, as being indefinite for failing to particularly point out and
4 distinctly claim the subject matter which the Appellants regard as the
5 invention.

6 Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable
7 over Takano and ABA.

8 Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable
9 over Ginter.

10

11 ISSUES

12 The issue of whether the Examiner erred in rejecting claims 1, 8, and
13 15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing
14 to particularly point out and distinctly claim the subject matter which the
15 Appellants regard as the invention turns on whether claims 1, 8, and 15
16 implicitly require a second notification that renders the claims indefinite.

17 The issue of whether the Examiner erred in rejecting claims 1-21
18 under 35 U.S.C. § 103(a) as unpatentable over Takano and ABA turns on

1 whether the combination of Takano and ABA describes a notification,
2 received by a second computer from a first computer, that includes a link
3 and a field for an electronic signature.

4 The issue of whether the Examiner erred in rejecting claims 1-21
5 under 35 U.S.C. § 103(a) as unpatentable over Ginter turns on whether it is
6 inappropriate for the Examiner to take Official Notice of a key limitation
7 and whether the Examiner's construction of a "link" is not consistent with
8 the definition provided in the Specification.

9
10 **FACTS PERTINENT TO THE ISSUES**

11 The following enumerated Findings of Fact (FF) are believed to be
12 supported by a preponderance of the evidence.

13 *Facts Related to the Prior Art*

14 *Takano*

15 01. Takano is directed to a system and method for preparing patent
16 specifications with inventors and persons in charge of filing patent
17 applications using a plurality of computers connected to a
18 communication network. Takano 1:8-18.

19 02. Takano describes that conventional systems transmits both
20 bibliographic information and a reference number assigned to a
21 patent application from an attorney-side computer to a client-side
22 computer. Takano 1:35-49.

23 03. Takano describes a system that uses a client computer to prepare
24 draft data on a specification of a patent application to report an
25 invention made by an inventor. Takano 5:52-61. The client
26 computer transmits the draft data and invention report to a server

1 computer. Takano 6:1-4. The client computer is enabled to
2 download the draft data and invention report by accessing the
3 storage address of the information thereby allowing the draft data
4 and invention report to be revised. Takano 8:7-24. Upon
5 completion of a revision, the client computer transmits the draft
6 data and invention report to the server computer. Takano 8:38-42.

7 *ABA*

8 04. ABA is directed to a discussion on an electronic filing system for
9 the United States Patent and Trademark office (USPTO). ABA 1.

10 05. In a first approach, a user can log in to a USPTO server and
11 validate their authority to electronically file and application, then
12 transmit a previously prepared application document. ABA 2. In
13 a second approach, the user is presented with a web browser
14 interface with HTML forms that a patent applicant fills in to
15 supply the bibliographic and procedural data. ABA 2. The web
16 browser also provides encryption and digital signature
17 capabilities. ABA 2. Upon receipt of an application, the USPTO
18 server will automatically issue a receipt indicating the date and
19 time when the application was received. ABA 3. A regular
20 application serial number will also be assigned and is used for
21 tracking the movement of files within the USPTO. ABA 3. A
22 participant will also be enabled to circulate completed applications
23 via e-mail to the actual signatory anywhere in the world for review
24 and signature. ABA 3.

06. A trial link will also be made available and the link will provide a set of HTML forms with all of the fields required for PCT applications. ABA 3.

Ginter

07. Ginter is directed to techniques, methods, and systems for providing reliable, trusted, verifiable delivery, handling, creation and/or execution of digital items such as documents, executable code, and/or any other information capable of being represented in digital form. Ginter 1:27-32.

ANALYSIS

Claims 1, 8, and 15 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention

The Examiner found that the claims require a single electronic notification but implicitly require a first electronic notification to the second computer and a second electronic notification from the second computer to the first computer. Ans. 4. The Appellants contend that claims 1, 8, and 15 only require a single notification, where the first computer sends a notification to a second computer. App. Br. 9 and Reply Br. 5.

We agree with the Appellants. Limitation [2] of claim 1 requires providing a second computer with a notification. Limitation [3] of claim 1 requires receiving the electronic notification at the first computer. The notification includes a link to an electronic document and a field for an

1 electronic signature. The notification sent from the first computer to the
2 second computer is the same notification that is returned from the second
3 computer to the first computer. Although one limitation requires providing a
4 field for an electronic signature whereas the other requires that the field
5 includes the electronic notification, it is still the same notification sent
6 between the computers. Since it is the same notification passed back and
7 forth between the first and second computers, a person with ordinary skill in
8 the art would have understood the process that the Appellants are claiming.
9 As such, claims 1; 8, and 15 are not considered to be indefinite.

10
11 *Claims 1-21 rejected under 35 U.S.C. § 103(a) as*
12 *unpatentable over Takano and ABA*

13 The Appellants contend that Takano and ABA fail to describe a
14 notification at a second computer including a link to a first computer and a
15 field for an electronic signature. App. Br. 15-16 and 25-26 and Reply Br. 6-
16 7.

17 We disagree with the Appellants. Limitation [2] of claim 1 requires a
18 providing a second computer with an electronic notification. The electronic
19 notification includes a link to an electronic document stored on the first
20 computer. The Appellants argue that the term “link” is specially defined as
21 “essentially an address” used to find the application on the server, such as a
22 URL address. App. Br. 15 and Spec. 27:25-31. While we agree that this
23 term is specially defined by the Specification, the term “essentially”
24 modifying the term “address” opens the scope of the claim to encompass
25 any identifier that is used to locate a document. Limitation [2] further
26 requires the electronic notification include a field for an electronic signature.
27 As such, the notification received by the second computer requires a link,

1 address, or other identifier to locate a document on the first computer and a
2 field for an electronic signature.

3 Takano describes a patent specification drafting system where patent
4 application documents are transmitted from a client computer to a server.
5 FF 03. The server stores the documents at a specific address and the client
6 computer can access the documents to make any further revisions. FF 03.
7 That is, Takano describes a system where a first computer, the server,
8 provides a second computer, the client computer, access to patent
9 application documents by providing the storage location of the documents
10 on the server.

11 ABA describes an electronic filing system to be used with the
12 USPTO. FF 04. ABA describes a user submits application information to a
13 USPTO server. FF 04. The USPTO server then transmits a notification to
14 the user indicating receipt of the application data and transmits a notification
15 to the user including a serial number that allows the user to access the
16 application information. FF 04. Under this construction, the USPTO server
17 is a first computer that provides the user or second computer an electronic
18 notification with a link, address, or serial number used to access application
19 documents.

20 As discussed *supra*, the scope of the term “link” encompasses any
21 identifier that is used to locate a document. The USPTO server further
22 provides users with encryption and electronic signature capabilities. FF 04.
23 This clearly suggests that a user has some means to submit an electronic
24 signature associated with application documents. As such the combination
25 of Takano and ABA describes a first computer that transmits a notification
26 to a second computer, where the notification includes a link, address, or

1 other identifier to locate a document on the first computer and a field for an
2 electronic signature. The Appellants also argue that ABA teaches away
3 from a feature that includes a notification at a second computer including a
4 link to a first computer and a field for an electronic signature. App Br. 15-
5 16. However, as discussed *supra*, ABA describes a link in a manner that is
6 consistent with its broad definition in the Specification. As such, the
7 Appellants' argument is not found to be persuasive.

8
9 *Claims 1-21 rejected under 35 U.S.C. § 103(a)*
10 *as unpatentable over Ginter*

11 The Appellants contend that it is inappropriate for the Examiner to
12 take Official Notice of a key limitation and the Examiner's construction of a
13 "link" is not consistent with the definition provided in the Specification.
14 App. Br. 16-18 and 21-22. However, since the rejection of claims 1-21 as
15 unpatentable over Takano and ABA is affirmed, we need not reach the
16 remaining arguments raised by the Appellants against the rejection of claims
17 1-21 as unpatentable over Ginter.

18
19 CONCLUSIONS OF LAW

20 The Examiner erred in rejecting claims 1, 8, and 15 under 35 U.S.C. §
21 112, second paragraph, as being indefinite for failing to particularly point
22 out and distinctly claim the subject matter which the Appellants regard as
23 the invention.

24 The Examiner did not err in rejecting claims 1-21 under 35 U.S.C. §
25 103(a) as unpatentable over Takano and ABA.

1 We do not reach whether the Examiner erred in rejecting claims 1-21
2 under 35 U.S.C. § 103(a) as unpatentable over Ginter.

3
4 **DECISION**

5 To summarize, our decision is as follows.

- 6 • The rejection of claims 1, 8, and 15 under 35 U.S.C. § 112, second
7 paragraph, as being indefinite for failing to particularly point out and
8 distinctly claim the subject matter which the Appellants regard as the
9 invention is not sustained.
- 10 • The rejection of claims 1-21 under 35 U.S.C. § 103(a) as unpatentable
11 over Takano and ABA is sustained.
- 12 • The rejection of claims 1-21 under 35 U.S.C. § 103(a) as unpatentable
13 over Ginter is not reached.
- 14

15 No time period for taking any subsequent action in connection with
16 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
17 § 1.136(a)(1)(iv) (2007).

18

19 **AFFIRMED**

20

21

22

23

24

25

26 hh